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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

In re application of David L. Kaminsky, et al.

Serial No.: 10/654,786

Filed: September 4, 2003

For: Policy-Based Management of Instant Message Windows

Art Unit: 2153

Examiner: Kevin T. Bates

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For Appellants

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**APPELLANTS' REPLY BRIEF**

This Reply Brief is submitted in furtherance of the Appeal Brief that was filed in this case on November 13, 2007, as amended with Supplemental Amendment filed December 2, 2007, and responds to the Examiner's Answer dated February 14, 2008.

## ARGUMENTS

1. Appellants respectfully submit the following comments on the Examiner's Answer dated February 14, 2008 (hereinafter, "the Examiner's Answer"). Line numbering cited herein for Appellants' claims refers to the claims as presented in Appellants' Appeal Brief dated November 13, 2007 (hereinafter, "Appellants' Appeal Brief").

2. Regarding paragraph 17 of Appellants' Appeal Brief, Appellants apologize for a typographical error in the quotation on lines 1 - 2 therein; this quotation should read "whether any of a selected list of application programs are active" (i.e., using "programs" in the plural).

3. The Examiner's Answer provides newly-cited paragraphs of Brown when referring to the claim language on lines 3 - 4 of Appellants' Claim 1, namely paragraphs [0066], [0083], and [0094] - [0097]. See the Examiner's Answer, p. 3, referring to the "defining ..." claim element. Appellants respectfully note that these paragraphs discuss priority settings to use with messages (para. [0066]), a technique for using a scale bar to set a general priority (para. [0083]), and criteria for increasing or decreasing the priority of an inbound message (paras. [0094] - [0097]).

4. However, as admitted in the Examiner's Answer on p. 3, final paragraph, "Brown does not explicitly indicate determining whether any of a selected list of application programs are active ..." (emphasis added).

5. Appellants also wish to note that this paragraph on p. 3 of the Examiner's Answer further

states “by the IM user” (i.e., “... determining whether any of a selected list of application programs are active by the IM user ...), which is not the claim language of their Claim 1. Claim 1, by contrast, states “programmatically determining, responsive to the receiving [of an instant message], whether any of the selected application programs in the list are currently executing on the computing device of the IM user” (Claim 1, lines 9 - 10, emphasis added).

6. Appellants also note the newly-provided admission on p. 5, last 2 lines (carrying over to page 6, line 1) of the Examiner’s Answer, which states “Brown does not teach any information that the window treatment or user profile contains any considerations about a list of applications [that] are being executed on the [user’s] computing device” (emphasis added). Appellants therefore respectfully submit that Brown should be removed as a reference.

7. Referring next to the first paragraph under section “**(10) Response to Argument**” on p. 5 of the Examiner’s Answer, the Examiner’s Answer states “The appellant argues that Brown does not teach defining policy information specifying criteria ...”, citing para. 12 of Appellants’ Appeal Brief. Appellants wish to clarify that para. 12 of Appellants’ Appeal Brief specifies, more particularly, that the cited para. [0055] of Brown has no apparent relevance to this “defining ... policy information ...” claim language from lines 3 - 6 of Appellants’ Claim 1.

8. Appellants also note that the first paragraph under “**The examiner disagrees:**” on p. 5 of the Examiner’s Answer states “In the 35 U.S.C. 103(a) rejection the examiner is relying on Brown to teach ... determining whether to open a new window ... based on the user’s status.” (emphasis

added). Appellants respectfully note that their claimed invention is not directed toward checking a “user’s status”. By contrast, lines 9 - 10 of Claim 1 recite “programmatically determining ... whether any of the selected application programs .... are currently executing ...” (emphasis added), and Appellants respectfully submit that currently-executing application programs are not the same as a user’s status.

9. Page 6, lines 1 - 2 of the Examiner’s Answer state that “Horvitz is being relied upon to teach the idea of the list of applications that are being executed on the computing device.”. Appellants do not admit that this is taught by Horvitz, and furthermore, Appellants respectfully submit that it is important to note that this is not what Appellants have claimed (in contrast to the assertion on p. 6, lines 3 - 4 of the Examiner’s Answer). That is, Appellants do not claim simply determining which applications are currently executing: Appellants claim language recites “... determining ... whether any ... application programs in the [defined] list are currently executing ...” (Claim 1, lines 9 - 10, emphasis added). Whereas the statement in the Examiner’s Answer implies that Horvitz consults the list of currently-executing applications (which, again, Appellants do not agree with), Appellants claim language goes further. That is, the “programmatically determining” claim element on lines 9 - 10 of Appellants’ Claim 1 impliedly compares this list of currently-executing programs to the defined list (i.e., the defined list as recited in the claim language at lines 3 - 6 of Claim 1) to thereby determine whether any application programs in the [defined] list are currently executing. It might happen, for example, that the list of currently-executing applications has no overlap with the defined list. Thus, Horvitz’s asserted checking of the currently-executing programs is clearly different from the implied comparing in Appellants’

“programmatically determining” element as recited on lines 9 - 10 of Claim 1.

10. Referring next to the first paragraph under “**The examiner disagrees**” on p. 6 of the Examiner’s Answer (i.e., the paragraph beginning “Horvitz teaches ...”), para. [0263] of Horvitz is cited, stating that Horvitz’s “complicated system” includes “looking at certain factors in [an] attempt to determine the user’s activities ... among these activities include recent application history, application in focus, and automated scene analysis”, referring to Fig. 34 and Fig. 38. Appellants respectfully note that para. [0263] of Horvitz discusses determining how busy the user is, by reasoning about whether the user is working, and reasoning about the rate at which the user is working. See para. [0263], lines 1 - 7; in particular, lines 3 - 7 state “It can be reasoned (e.g. inferential decision-making) about whether and the rate at which a user is working on a computer, or whether the user is on the telephone, speaking with someone, or at a meeting in another location.” (emphasis added). Appellants respectfully submit that using reasoning and inference to make decisions about whether the user is on the phone, at a meeting, or using his computer is clearly distinct from their claimed “programmatically determining ... whether any ... application programs in the [defined] list are currently executing on the computing device of the IM user” (Claim 1, lines 9 - 10, emphasis added). Notably, this claim limitation from Appellants’ Claim 1 does not require any reasoning or inference.

11. Para. [0263] also discusses “assess[ing] a user’s activity or his or her focus of attention” (para. [0263], lines 8 - 9, emphasis added). By contrast, the “determining” claimed by Appellants does not assess the user’s activity, and does not assess the user’s current focus of attention. (See

paras. 19 and 32 of Appellants' Appeal Brief, where this has been discussed.)

12. Para. [0263] of Horvitz further states that a Bayesian network can be used to infer a user's activity. See para. [0263], lines 9 - 12, "A Bayesian network can then be used for performing an inference about a user's activity." (emphasis added). This so-called "complicated system" (Examiner's Answer, p. 6, as discussed above in para. 10), with its Bayesian network for performing inference, is clearly distinct from Appellants' determining whether any application programs from a [pre]defined list are currently executing (referring to the claim language in Claim 1, lines 9 - 10).

13. Appellants also respectfully note that the carryover paragraph on p. 6 - 7 of the Examiner's Answer (i.e., the paragraph that begins "It is almost impossible ...") clearly suggests a prohibited hindsight reasoning approach to evaluating Appellants' claim language. See, for example, the following statements within this paragraph: "It is almost impossible to monitor ..."; "It seems hard to consider ..."; "The examiner contends ...".

14. Finally, the last sentence of this carryover paragraph from the Examiner's Answer states "The examiner contends that for the system to know what is the user's application history and what the user is actively focused on the system must keep track of the applications on the user's machine and it uses that information to determine the user's activities." (emphasis added). Appellants respectfully note that their claim language does not pertain to the user's application history, which by definition is a past-tense concept (see para. 32 of Appellants' Appeal Brief,

where this has been discussed), and it also does not pertain to what the user is actively focused on. With regard to this user focus concept, para. 19 of Appellants' Appeal Brief noted that the user might be focused on the user's instant messaging application, which is explicitly excluded from the list under consideration. And, with regard to the statement on p. 7, lines 1 - 2 of the Examiner's Answer that the system of Horvitz "uses that information to determine the user's activities", Appellants reiterate that their claimed invention is not directed to a user's activities.

15. Accordingly, Appellants maintain their position with regard to independent Claims 1, 27, and 29 that the cited references do not teach or suggest all of the limitations specified therein. Furthermore, Appellants maintain their position that dependent Claims 9 and 15 are allowable over the references by virtue of the allowability of the independent claims from which they depend.

### **CONCLUSION**

In view of the above, Appellants respectfully submit that the rejection of appealed Claims 1, 9, 15, and 28 - 29 is overcome. Accordingly, it is respectfully urged that the rejection of appealed Claims 1, 9, 15, and 28 - 29 not be sustained.

Respectfully submitted,

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